

REMARKS

Claims 1, 3-12, 40-42 and 45-50 are presently pending; claims 2, 13-39, 43 and 44 are canceled without prejudice.

The Examiner's indication that claims 46-50 would be allowable if rewritten in independent form is noted with appreciation. Claim 46 has been rewritten in independent form, and claims 47-50 depend therefrom.

Claim 40 was rejected under 35 U.S.C. 112, second paragraph. However, clarification of this rejection is requested, as the language identified in the Office action is not found in the claim.

Claim 1 was provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of Application No. 10/763,534. This provisional rejection will be addressed should claim 1 be allowed.

Claims 1 and 3-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,846,052 to Favre et al. in view of U.S. Patent No. 4,925,683 to Fischbach et al. It is respectfully submitted that claims 1 and 3-12 are not unpatentable over Favre in view of Fischbach.

Favre does not disclose a cartridge having an inlet, an outlet and an air inlet. Instead, the cartridge 16 of Favre is pierced using an injection element 6 of an extraction device 1 and fluid exists the cartridge when the cover 19 splits along a weakening line. The exiting fluid then flows into a space between the cartridge 16 and the cartridge holder 15. From this space, fluid exits through the passage 22. The air inlet opening 23, referenced in the Office action, is not an air inlet of the cartridge 16 but to the space between the cartridge 16 and the cartridge holder 15.

Fischbach also does not disclose a cartridge an inlet, and outlet and an air inlet. Instead, Fischbach discloses an envelope with neither an inlet nor an outlet, but rather the envelope is dissolvable.

Given than neither Favre nor Fischback disclose a cartridge having an inlet, an outlet and an air inlet, their proposed combination suggested in the Office action also will lack the same.

Claims 40-42 and 45 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,471,689 to Piana in view of Fischbach. It is respectfully submitted that claims 40-42 and 45 are not unpatentable over Piana in view of Fischbach.

Piana does not disclose an outer member and an inner member contained within the outer member, as presently recited in claim 40. Instead, Piana discloses a two part cartridge with a cup part 12 having an opening covered by a lid part 14. The lid part 14 is not disposed entirely within the cup part 12, as illustrated in Fig. 2, and thus is not contained within the outer member. Fischbach also does not disclose the claimed outer member and inner member, but rather an envelope.

Moreover, and as discussed in the prior Amendments, Piana does not disclose a cartridge for use in a beverage preparation machine contain a beverage ingredient that is a liquid chocolate ingredient. To the contrary, Piana discloses a cartridge containing "powdery or granular matters, such as blends of powdered cocoa and powdered milk for the preparation of hot chocolate beverage." (Col. 2, ll. 47-50.) Piana also states that its "invention relates to a disposable cartridge...which contains a dose of water-soluble granular, powdery or similar particulate matter..." (Col. 1, ll. 9-12.)

There is no motivation identified in the Office action in either Piana or Fischbach for their proposed combination. In fact, Piana teaches away from its use with a liquid product by stating that it is directed to a cartridge that purports to address deficiencies with prior cartridges for "freeze-dried or other water soluble products..." (Col. 1, l. 57 – col. 2, l. 4.) Fischbach teaches away from its use with a cartridge such as Piana because it is directed to a dissolvable envelope.

In view of the foregoing comments, it is respectfully submitted that claims 1, 3-12, 40-42 and 45 are allowable, and reconsideration and allowance are respectfully requested.

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Amendment dated Oct. 31, 2007
Reply to the Office action of Sep. 17, 2007

The Commissioner is hereby authorized to charge any additional fees which may be required in this application to Deposit Account No. 06-1135.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

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